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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,615	07/11/2000	Cheryl L. Neofytides	10722-32691	1081

26702 7590 09/21/2005

MORRIS, MANNING & MARTIN LLP  
6000 FAIRVIEW ROAD  
SUITE 1125  
CHARLOTTE, NC 28210

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**OIPE/IAP**

**SEP 28 2005**

EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

( )

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/613,615	NEOFYTIDES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James H. Zurita	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 June 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 91-148 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) \_\_\_\_\_ is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) 91-148 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

On 13 June 2005, applicant cancelled claims 30-37 and 39-51. Applicant added claims 91-148.

The introduction of new claims necessitates the Election Restrictions Requirement that follows. The new claims also appear to be directed to invention(s) that are independent or distinct from the invention originally presented for reasons explained below.

***Election/Restrictions Requirement***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Invention I.** Claims 91-113, drawn to methods of providing a money transfer service between first party and a second party through a payment enabler system, classified in class 705, subclass 75.

**Invention II.** Claims 114-130, drawn to methods for making an online payment from a first party to a second party through a payment enabler system, classified in class 705, subclass 64.

**Invention III.** Claims 115-148, drawn to methods for enabling a first party to request and receive an online payment from a second party through a payment enabler system, classified in class 705, subclass 75.

**Inventions I and II** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires

- (a) maintaining at the payment enabler system a database of registered users that have registered with the payment enabler system, the database comprising a plurality of records that include an email address and other account information including a default payment method and a default money receiving method;

The subcombination has separate utility such as

- (e) in response to a determination that the second party, has no entry in the registered users database, receiving **security** information from the first party including predetermined expected information for purposes authenticating the second party for receiving the payment;
- (f) in response to receipt of the **security** information from the first party, sending the second party a registration invitation email utilizing the retrieved email address to notify the second party that a payment is pending and instructing the second party to register with the payment enabler system by accessing the payment enabler system;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

**Inventions I and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d).

In the instant case, invention I has separate utility such as

- (a) maintaining at the payment enabler system a database of registered users that have registered with the payment enabler system, the database comprising a plurality of records that include an email address and other account information including a default payment method and a default money receiving method;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one is not required for the other, restriction for examination purposes as indicated is proper.

**Inventions II and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d).

In the instant case, invention II has separate utility such as

- (e) in response to a determination that the second party, has no entry in the registered users database, receiving **security** information from the first party including predetermined expected information for purposes authenticating the second party for receiving the payment;
- (f) in response to receipt of the **security** information from the first party, sending the second party a registration invitation email utilizing the retrieved email address to notify the second party that a payment is pending and instructing the second party to register with the payment enabler system by accessing the payment enabler system;

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application also contains claims directed to the following patentably distinct species of the claimed invention:

Art Unit: 3625

If applicant chooses **Invention I**, the applicant must select one of the following species. Claim 91 is generic.

I.a	91, 92, 93	I.j	91, 103
I.b	91, 92, 94	I.k	91, 104
I.c	91, 95	I.l	91, 105
I.d	91, 96, 136	I.m	91, 106, 107
I.e	91, 97	I.n	91, 106, 108
I.f	91, 98	I.o	91, 106, 109
I.g	91, 99, 100	I.p	91, 110
I.h	91, 101	I.q	91, 111
I.i	91, 102		

If applicant chooses **Invention II**, the applicant must select one of the following species. Claim 114 is generic.

II.a	114, 115	II.i	114, 123
II.b	114, 116	II.j	114, 124
II.c	114, 117	II.k	114, 125
II.d	114, 118	II.l	114, 126
II.e	114, 119	II.m	114, 127
II.f	114, 120	II.n	114, 128, 129
II.g	114, 121	II.o	114, 130
II.h	114, 122		

If applicant chooses **Invention III**, the applicant must select one of the following species. Claim 131 is generic.

III.a	131, 132
III.b	131, 133
III.c	131, 134
III.d	131, 135
III.e	131, 137
III.f	131, 138
III.g	131, 139
III.h	131, 140
III.i	131, 141, 142
III.j	131, 141, 143
III.k	114, 144
III.l	114, 145
III.m	114, 146, 147
III.n	114, 146, 148

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
**7 September 2005**

*James Zurita*  
*Patent Examiner*  
*Art 3625*

Organization **IC 3600** Blg./Rooftop **KNOX**  
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